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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/675,684

Filing Date: September 30, 2003

Appellant(s): GAETANO ET AL.

Michelle Whittington (Reg. No. 43,844)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 26, 2010 appealing from the Office action mailed April 26, 2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

- Claims 1-5, 7-34 are pending.
- Claims 1-4, 5, 7, and 9 are rejected.
- Claims 11-35 are withdrawn.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. 35 USC 112, 1st paragraph and 35 USC 112, 2nd paragraph.

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

20020049679	RUSSELL et al.	4-2002
6189146	MISRA et al.	2-2001
7209902	STEFIK et al.	4-2007

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication No. 2002/0049679 to Russell et al. ("Russell") in view of US Patent No. 6189146 to Misra et al. ("Misra").

Referring to claim 1, Russell discloses a client site having a target hardware device (i.e. user-network enabled device), said hardware device having a unique identifier see paragraphs [0009] & [0049] – UND with hard drive serial number), a virtual warehouse website created specifically for a single end user (i.e. protected database, which is stored on a particular user-network enabled device) comprising a personal inventory of intangible software selected for storage because each of said component is compatible with said target hardware device(see paragraphs [0011] & [0031]), a license generator generating a software site license comprising one or more of said components for said target hardware device, aid software site license being stored in said virtual warehouse storage for later use (see paragraphs [0047] &[0045]) and a programming workstation in communication with said target hardware device (i.e. media player), said programming workstation displays said components of said end user virtual warehouse for said end user to select and confirm contents of said software site license (see paragraphs [0010] & [0054] and receiving said software site license from said virtual warehouse storage for said target device (see paragraphs [0012] &[0014]). Russell does not expressly disclose displaying to select and confirm contents of said software site license prior to license. However, this is an intended use feature and the Examiner notes that the workstation of Russell is capable of performing the process. "A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art, if the prior art has the capability to so perform" (see MPEP 2114 and Ex parte Masham, "2 USPQ2d 1647

(1987)). Also, Russell does not expressly disclose the programming workstation is separate from said target hardware device and receiving said software site license from said virtual warehouse storage on behalf of said target device until installation of said license on said target. However, Misra discloses this feature (see fig. 1 and related text - the license server receives the license from the license generator and sends it to the client). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclosed by Russell to include the features of Misra. One of ordinary skill in the art would have been motivated to do this because it prevents issued license form being copied from one client machine to another (see col. 3, lines 15-20). Also, modifying the reference to have more than one parts perform a task previously performed by one part is analogous to making functions, structures, or actions separable. It has been held that constructing a formerly integral structure in various elements involves only routine skill in the art (see *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) and MPEP §2144.04 V.C).

Referring to claim 2, Russell discloses the system wherein said programming workstation receives an electronic file transfer comprising said license (see paragraph [0026]).

Referring to claim 3, Russell in combination with Misra discloses the system wherein said programming workstation retains a copy of said site license after installation (see claim 28 of Russell and fig. 1 of Misra).

Referring to claim 7, Russell discloses the system wherein said license sales site receives a purchase order from said client site comprising said target hardware device in response to said order, said license sales site establishes said virtual warehouse for said client site and places said

licensable components for said target hardware device in said virtual warehouse (see claim 1 above).

Referring to claim 9, Russell discloses a representative of said client site (i.e. user) and a purchase order prepared by said representative and received at said license sales site, said order comprising said target hardware device, said representative having said programming workstation and installing said license to said target sales device prior to delivering said target to said client site (see claim 1 above).

3. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russell and Misra as applied to claim 1 above, and further in view of U.S. Patent No. 7209902 to Stefik et al. (“Stefik”).

Russell discloses a virtual warehouse and performing integrity check (see claim 1 above and paragraph [0063]). Russell does not expressly disclose the system wherein said virtual warehouse comprises a multi-password protected website comprising entry of a password unique to said client site and an ID unique to said target hardware device or comprising a priority level of access to said virtual warehouse. Stefik discloses the system wherein said virtual warehouse comprises a multi-password protected website comprising entry of a password unique to said client site and an ID unique to said target hardware device or comprising a priority level of access to said virtual warehouse (see claims 1 and 22). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the system disclosed by Russell to include a virtual warehouse comprises a multi-password protected website comprising entry of a password unique to said client site and an ID unique to said target hardware device and a priority level of access to said virtual warehouse. One of ordinary skill in the art would have

been motivated to do this because it prevents unauthorized individuals from accessing the system.

(10) Response to Argument

A. Appellant's Claims are Patentable over the combination of Russell and Misra Primary Reference - Russell

4. Appellants argue that Russell does not teach a virtual warehouse containing a personal inventory of intangible software components being associated with only a particular hardware device unique identifier and that the catalog in Russell is not specific to any one user or device, but rather is a catalog of all movies for rental.

However, the examiner respectfully disagrees. Russell teaches transferring content and its license to a particular user enabled device. The device comprises a protected database that stores the received information (see paragraphs [0011] & [0031]). Thus, the receipt and storage of the received information implies an association because the data is unique to that user-enabled device.

5. Appellants argue that "the Examiner is incorrectly stating that the virtual warehouse website is within or on the target hardware device. Applicant's virtual warehouse website storage is not located on the target hardware device nor do Applicant's claim recite this".

However, the claims do not indicate that the virtual warehouse and the target hardware are separate. The Examiner notes the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Also note that the claim indicates the programming workstation is separate from the target hardware device; specifically, "a programming workstation in communication with but separate from said target hardware device". However, the claim does not state that the virtual warehouse website is separate from the target hardware device.

6. Appellants argue that Russell fails to disclose that "the license is generated from the stored software component for the target hardware device and stored in a virtual warehouse storage for later use.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., license is generated **from the stored software component**) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Functional recitation(s) using the word "for" or other functional language have been considered but are given little patentable weight¹ because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) ("The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself."); *In re*

¹ See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that

Otto, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

Further, as expressed in the Office Action, Russell disclose “a license generator generating a software site license comprising one or more component for said target hardware device, said software site license being stored in said virtual warehouse storage for later use (see paragraphs [0047] & [0045]).

Secondary Reference - Misra

7. Appellants argue that Misra does not teach "a personal inventory of intangible software components being associated in a virtual warehouse specifically for a single end user and for a specific hard device unique identifier.

As expressed in the Office Action, This feature is taught by the primary reference, Russell.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

B. Appellant's Claims are Patentable over the combination of Russell, Misra and Stefik

Appellants argue that Stefik the Examiner rejected the claim without any other explanation of how Stefik teaches Appellants claims 4 and 5.

although all limitations must be considered, not all limitations are entitled to patentable weight).

However, the Examiner respectively disagrees. The Examiner stated that Stefik teaches the system wherein said virtual warehouse comprises a multi-password protected website comprising entry of a password unique to said client site and an ID unique to said target hardware device or comprising a priority level of access to said virtual warehouse and directs Appellants to claims 1 and 22 of Stefik. Stefik teaches the missing elements of Russell, see claims 1, 21, and 22 of Stefik, which discusses the concept of claims 4 and 5.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Jalatee Worjloh/

Primary Examiner, Art Unit 3685

Conferees:

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685

Vincent Millin /vm/

Appeals Practice Specialist